

REMARKS

I. Status of Claims and Final Office Action Summary

Applicants propose to amend independent claims 1 and 14 as set forth above, and the amendments find support in Applicants' specification at, for example, page 3, lines 20-23. Claims 1-10 and 12-14 remain pending and under current examination.

The Final Office Action:

- (a) rejected claims 1-5, 7-10, and 12-14 under 35 U.S.C. § 103(a) as being unpatentable over EP 268 938 ("Kadokura") in view of U.S. Pat. App. Pub. No. 2002/0009564 ("Hall") and U.S. Patent No. 7,101,536 ("Mongiat") (Final Office Action at 2); and
- (b) rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Kadokura and Mongiat, further in view of WO 01/43714 ("Reinehr") (Id. at 4).

II. Response to Final Office Action

A. Rejection of Claims 1-5, 7-10, and 12-14

Applicants respectfully traverse the rejection of claims 1-5, 7-10, and 12-14 under 35 U.S.C. § 103(a) as being unpatentable over Kadokura in view of Hall and Mongiat for at least the following reasons.

In making a rejection under 35 U.S.C. § 103, the Examiner "bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. See M.P.E.P. § 2142. In its decision in *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q. 2d 1385 (2007), the Supreme Court confirmed that the "framework for applying the statutory language of §103" was still based on its landmark decision in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966).

Under *Graham*, there are four factors for consideration when determining whether an invention is obvious:

- (1) the scope and content of the prior art;
- (2) the differences between the prior art and the claims at issue;
- (3) the level of ordinary skill in the art; and
- (4) secondary considerations.

383 U.S. at 17, 148 U.S.P.Q. at 467. However, the Court indicated that there is no necessary inconsistency between the idea underlying the teaching, suggestion, or motivation (“TSM”) test and the *Graham* analysis. *KSR*, 127 S. Ct. at 1741, 82 U.S.P.Q. 2d at 1389. As long as the TSM test is not applied as a “rigid and mandatory” formula, the test can provide “helpful insight” to an obviousness inquiry. *Id.*

Kadokura does not disclose or suggest Applicants’ claimed invention as recited in independent claim 1. For example, Kadokura does not disclose or suggest at least “porous silica particles having ... an optically active substance incorporated into said porous silica particles,” as recited in claim 1. Instead, Kadokura discloses a lamina comprising “a laminar substance as a matrix and a finely divided metal or metal compound dispersed therein.” Kadokura, page 2, lines 1-2. Silica may be the material of the matrix. *Id.*, page 5, lines 25-26. Kadokura does not disclose that the laminar substance is porous, but the Final Office Action relies on Hall to allegedly overcome this deficiency.

Hall discloses poly(methylsilsequioxane) that is partly or completely calcined, where calcining to remove all organic groups converts poly(methylsilsequioxane) to silica. Hall, paragraphs [0016] and [0023]. Hall suggests that calcination imparts porosity to poly(methylsilsequioxane). *Id.*, paragraph [0025]. The Final Office Action compares the combination of Kadokura and Hall to the claimed porous silica particles

recited in claim 1. Final Office Action at 5. Applicants respectfully disagree with this comparison. As noted above, Kadokura's lamina comprises a matrix material and a finely divided metal or metal compound dispersed therein. Even if silica is used as the matrix material, the silica is considered to be porous due to the teachings of Hall, and the finely dispersed metal or metal compound is considered to be an optically active substance, none of which Applicants concede, Kadokura's lamina is still not "a porous silica particle[] ... [with] an optically active substance incorporated into said porous silica particles," as recited in claim 1. This is at least because Kadokura's lamina does not have an optically active substance incorporated in the matrix material. Instead, the finely divided metal or metal compound of Kadokura's lamina is apparently dispersed within and adjacent to the matrix material.

Moreover, the Final Office Action alleged that Hall "was solely used to show that the lamina of Kadokura are calcined at ranges between 300 C and 700 C and Hall teaches that the silicon particles calcined at about 300 C to about 400 C, produce porous particles." Final Office Action at 5-6. Without acceding to these allegations, Applicants submit that Kadokura discloses in Example 1 calcining at 300°C and then calcining at 700°C, but refers to a titania lamina with finely divided silica, not a silica-based lamina. Kadokura, page 6, lines 37-45. Further, Kadokura's Example 10, cited on page 3 of the Final Office Action, is a titania-silica lamina with finely divided titania, and is calcined at 450°C, which is outside Hall's disclosed temperature range for calcining, 300°C to 400°C. Hall, paragraph [0024]. Thus, Applicants do not accede to the Office's allegation that the proposed combination of Kadokura and Hall discloses or suggests that Kadokura's lamina is porous.

Further, Kadokura does not disclose or suggest that “upon application of said cosmetic composition to skin, the optically active substance does not directly contact said skin,” as recited in the proposed amendment to independent claim 1. The optically active substance recited in claim 1 does not directly contact skin, at least because it is incorporated in the porous silica particle of claim 1. See Applicants’ specification, page 3, lines 20-23. In contrast, Kadokura’s lamina, if used in a cosmetic, would apparently allow both the matrix material and the finely dispersed metal or metal compound to directly contact skin.

Hall does not overcome the deficiencies of Kadokura. Hall is directed to reducing friction between PET preforms and bottles, and discloses adding poly(methylsilsequioxane) to PET to “reduce surface friction without producing objectionable levels of haze” in the PET. Hall, Abstract and paragraph [0016]. Hall does not disclose or suggest at least that “upon application of said cosmetic composition to skin, the optically active substance does not directly contact said skin,” as recited in the proposed amendment to independent claim 1.

Mongiat also does not overcome the deficiencies of Kadokura. Mongiat discloses UV-protection formulations (Mongiat, Abstract) but does not disclose or suggest at least that “upon application of said cosmetic composition to skin, the optically active substance does not directly contact said skin,” as recited in the proposed amendment to independent claim 1.

For at least these reasons, independent claim 1, as proposed to be amended, should be allowable over Kadokura, Hall, and Mongiat. Independent claim 14 differs in scope from claim 1 but is also proposed to be amended to recite that “upon application

of said cosmetic composition to skin, the optically active substance does not directly contact said skin." Independent claim 14, as proposed to be amended, should be allowable at least for reasons similar to those presented regarding claim 1. Claims 2-5, 7-10, 12, and 13 should be allowable at least due to their dependence from claim 1. Applicants, therefore, respectfully request reconsideration and withdrawal of the rejection of claims 1-5, 7-10, and 12-14.

B. Rejection of Claim 6

Applicants respectfully traverse the rejection of claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Kadokura and Mongiat, further in view of Reinehr for at least the following reasons. As explained above, independent claim 1, as proposed to be amended, should be allowable over Kadokura and Mongiat. Reinehr is cited for its alleged disclosure of the use of fluorescent substances (Final Office Action at 5), but without acceding to this characterization of Reinehr, Applicants submit that Reinehr does not overcome the deficiencies of Kadokura and Mongiat. This is at least because Reinehr does not disclose or suggest that "upon application of said cosmetic composition to skin, the optically active substance does not directly contact said skin," as recited in independent claim 1, as proposed to be amended. For at least these reasons, independent claim 1, as proposed to be amended, and claim 6 which depends from claim 1, should be allowable over Kadokura, Mongiat, and Reinehr. Applicants, therefore, respectfully request reconsideration and withdrawal of the rejection.

III. Conclusion

Applicants respectfully request that this Amendment After Final be entered, placing claims 1-10 and 12-14 in condition for allowance. The proposed amendments to claims 1 and 14 do not raise new issues or require an additional search, and therefore this Amendment After Final should allow for immediate action by the Examiner. Thus, in view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of the present application, and timely allowance of the pending claims.

The Examiner may contact the undersigned with any questions or comments.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 25, 2010

By: /Brandon B. Crisp/
Brandon B. Crisp
Reg. No. 63,138
(571) 203-2768